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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,013	03/16/2004	Bruce F. Molino	20011/1331	4932

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EXAMINER

CORDERO GARCIA, MARCELA M

ART UNIT	PAPER NUMBER
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1654

DATE MAILED: 04/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/802,013	Applicant(s) MOLINO ET AL.	
	Examiner Marcela M. Cordero Garcia	Art Unit 1654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-188 is/are pending in the application.
- 4a) Of the above claim(s) 4-188 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>6/04, 12/05 & 2, 3/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's election with traverse of Group I, claims 1-103 in the reply filed on December 22, 2005 is acknowledged

The species elected by Applicant is a compound of Formula (I) wherein A is an amino acid of Formula (II) and wherein R_0 is CH_3 ; R_1 is $CH=CHC(=O)Me$; X is hydroxyl; B is α -aminobutyric acid; C is a sarcosine; D is N-methyl leucine; E is valine; F is an N-methyl leucine; G is alanine; H is D-alanine; I is N-methyl leucine; J is N-methyl leucine; and K is N-methyl valine. Claims 1-3 are readable thereon.

Applicant's elected species was searched and found free of the prior art. Claim 3 is drawn exclusively to this species and would be allowable if written in independent form.

Another species from amongst those encompassed by the instant claims was selected and searched by Examiner, namely, a compound of Formula (I) wherein A is an amino acid of Formula (II) and wherein R_0 is CH_3 ; R_1 is $CR_{13}R_{14}R_{15}$ with $R_{13} = R_{14} = H$ and $R_{15} =$ substituted and unsubstituted C_2 - C_6 -straight alkenyl chain; X is hydroxyl; B is α -aminobutyric acid; C is a sarcosine; D is N-methyl-leucine; E is valine; F is an N-methyl leucine; G is alanine; H is D-alanine; I is N-methyl leucine; J is N-methyl leucine; and K is N-methyl valine.

Claim 1 is readable upon Examiner's elected species and are presented for examination on the merits.

Claims 4-188 are withdrawn as not drawn to either one of examined species.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Wenger (Transplantation Proceedings, 1990, cited in the IDS of 6/30/04) or by Bollinger et al. (US 4,384,996, cited in the IDS of 12/22/05).

Each reference teaches a compound of Formula (I) wherein A is an amino acid of Formula (II) and wherein R₀ is CH₃; R₁ is CR₁₃R₁₄R₁₅ with R₁₃ = R₁₄ = H and R₁₅ = substituted and unsubstituted C₂-C₆-straight alkenyl chain; X is hydroxyl; B is α-aminobutyric acid; C is a sarcosine; D is N-methyl-leucine; E is valine; F is an N-methyl leucine; G is alanine; H is D-alanine; I is N-methyl leucine; J is N-methyl leucine; and K is N-methyl valine (See Wenger, e.g., Figure 1, page 1104 and Bollinger et al., columns 3 and 4).

Therefore, the references are deemed to anticipate the instant claim above.

Specification

At page 64, line 32, the typographical error "*Triametes versicolor*" needs to be corrected for --*Trametes versicolor*--.

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At page 65, lines 4-5, the phrase "*T. villosa*, *P. ostreatus*, *P. versicolor*" requires complete names for each laccase catalyst source, e.g., *Trametes villosa*, *Pleurotus ostreatus*, and so forth.

Please note that the corresponding claim 106, although not being currently examined, also presents the same incomplete names.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of copending Application No. 11/232,292. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instantly claimed invention and the invention

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claimed in Application '808 are both drawn to compounds of Formula (I) with an amino acid of Formula (II). Further, the instantly claimed compound encompasses and/or is encompassed by the claimed compound of '292.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. 11/232,360. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instantly claimed invention and the invention claimed in Application '360 are both drawn to compounds of Formula (I) with an amino acid of Formula (II). Further, the instantly claimed compound encompasses and/or is encompassed by the claimed compound of '360.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

No claim is allowed.

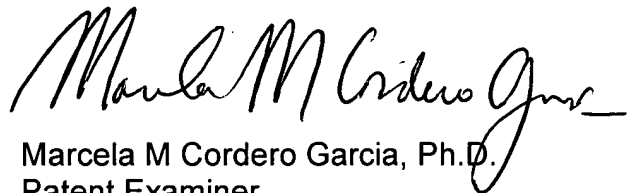
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marcela M. Cordero Garcia whose telephone number is (571) 272-2939. The examiner can normally be reached on M-Th 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell can be reached on (571) 272-0974. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Marcela M Cordero Garcia, Ph.D.
Patent Examiner
Art Unit 1654

MMCG 04/06



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